

REMARKS

Claims 1-3, 5, 8-23, 25 and 27-60 are pending in the above-captioned patent application after this amendment. Claims 1-39 have been rejected, although no explanation of the rejection was provided by the Patent Office relative to claims 27-33. Although the Applicants do not agree with the rejections, claims 40-60 have been added, claims 1, 5, 8, 11, 19, 21 and 25 have been amended, and claims 4, 6, 7, 24 and 26 have been canceled without prejudice by this amendment to expedite prosecution of the Application, even though the Applicants believe that claims 1-39, as originally presented, were patentable.

Support for the amendments to the claims and the new claims can be found throughout the originally filed specification, in the drawings and in the claims. More specifically, support for new claims 40-60 can be found at least in Figures 3-18, and in the specification at page 8, line 11 through page 16, line 31.

No new matter is believed to have been added by this amendment.

Reconsideration of the rejected claims and consideration of the new claims is respectfully requested in view of the above-recited amendments and the arguments set forth below.

INTERVIEW SUMMARY

On July 12, 2001, the undersigned attorney for the Applicants conducted a telephonic interview with the Examiner, Dan Jenkins. Prior to the interview, a draft response was forwarded to the Patent Office. During the Interview, the draft response was discussed. Further, the Examiner and the undersigned attorney discussed claim language that would likely place one or more of the claims in a condition for allowance. Claims 1 and 21 have been amended in view of the telephonic interview. Further, the Examiner preliminarily agreed that the term "substantially", as used in the claim language, was appropriate. Moreover, during the interview, the Examiner indicated that U.S. Patent No. 6,157,099 should have been cited to reject claims 21-26 and 34-39 under the judicially created doctrine of obviousness-type double patenting, instead of U.S. Patent

No. 5,861,696. The Applicants wish to thank the Examiner for his time and assistance during the interview.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-26 are rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected, to make and/or use the invention. The term 'substantially' found throughout Applicant's disclosure including claims is not supported so that one of ordinary skill in the art at the time of the invention would understand the limitations of this term." Further, the Patent Office indicates that the Applicants have "presented no guidance as to the definiteness of this term." The Applicants hereby respectfully traverse the rejection of the Patent Office.

35 U.S.C. § 112, first paragraph contains three separate and distinct requirements: (i) adequate written description, (ii) enablement, and (iii) best mode. In the present case, the written description adequately identifies what the applicant has invented and the best mode has been disclosed. Further, the disclosure enables one skilled in the art to make and use the invention as claimed without undue experimentation. Accordingly, the Applicants respectfully submit that the rejection of claims under 35 U.S.C. § 112, first paragraph is inappropriate.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term 'substantially' found within the claims is not definite in that one of ordinary skill in the art could not reasonably ascertain the limitation of the term." Applicants respectfully traverse the rejection of the Patent Office for the reasons which follow.

35 U.S.C. § 112, second paragraph, contains two separate and distinct requirements, namely, (A) the claims must set forth the subject matter that

applicants regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. MPEP § 2171.

To interpret whether these criteria have been satisfied, MPEP § 2173.02 provides guidelines to be followed by the Patent Office. MPEP § 2173.02 states in relevant part:

“When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a *reasonable* degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” (Emphasis original and added.) MPEP § 2173.02.

Pending claims 1-3, 5, 8-23 and 25 define the patentable subject matter with a reasonable degree of particularity and distinctness notwithstanding the usage of the term “substantially” in conjunction with the terms “parallel” and “transversely”. In compliance with the MPEP, latitude in the manner of expression should be permitted.

Further, case law supports the usage of the term “substantially”. For example, in Andrew Corporation v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010, the U.S. Court of Appeals for the Federal Circuit *reversed* the District Court’s ruling that a patent was invalid for indefiniteness. The Court of Appeals held that the patent was not invalid, even though the applicant used words such as “approach each other”, “close to”, “substantially equal” and “closely approximate”. The court relied on Seattle Box Co. v. Industrial Crating & Packing, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1983), which remarked that “substantially equal” is a term of degree, and that its acceptability depends on “whether one of ordinary skill in the art would understand what is claimed ... in light of the specification, even if experimentation may be needed.” A review of the specification of the issued patent shows that no guidance or definition for “substantially” was provided. (See U.S. Patent No. 4,410,892

issued to Knop, et al.) Nevertheless, the court found that the term "substantially" was not indefinite. (See also, In re Mattison, 509 F2d 563, 184 USPQ 484 (1975); U.S. Patent No. 3,939,203 issued to Mattison, et al., wherein no definition of the term "substantially" is provided in the specification.)

Additionally, as summarized by the Second Circuit Court of Appeals, "If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." Georgia Pacific Corp. v. United States Plywood Corp., 258 F.2d 124, 136, 118 USPQ 122, 132 (2d Cir.), cert. Denied, 358 U.S. 884, 79 S.Ct. 124 (1958). (Emphasis added.)

Moreover, claims 11, 19 and 20 do not include "substantially" anywhere in the claim language. Consequently, there is no reasonable basis for rejecting these claims. Based on the foregoing reasons, Applicants respectfully request that the Patent Office withdraw its rejection of the claims under 35 U.S.C. § 112, second paragraph.

Rejections under the Doctrine of Obviousness-type Double Patenting

Claims 21-26 and 34-39 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over one or more of the claims of U.S. Patent No. 6,157,099. (See Interview Summary above). The Applicants have filed concurrently herewith a Terminal Disclaimer in compliance with 37 CFR 1.321(c). Thus, the rejection by the Patent Office has been overcome.

NEW CLAIMS

New claims 40-60 have been added by this amendment. New claims 40-60 are of a slightly different scope than the previously pending claims. However, new claims 40-60 are believed to be patentable in view of the cited references. New claims 40-52 depend directly or indirectly from pending claims 1, 11 or 27, which are believed to be patentable as explained above.

New independent claim 53 is directed toward a "manufacturing fixture ... comprising ... a fixture body including a fixture cavity ... having a cavity axis, the fixture cavity including an upper side and a lower side that are positioned substantially perpendicular to the cavity axis, the upper side and the lower side being substantially planar; and ... and an orientating device adapted to create a magnetic field having flux lines which extend through a portion of the fixture cavity, wherein a portion of the flux lines in the fixture cavity are angled relative to the remaining flux lines in the fixture cavity." In view of the cited references, new claim 53 is believed to be patentable. Because claims 54-58 depend directly or indirectly from claim 53, they are likewise considered to be patentable.

Further, new claim 59 is directed toward a "manufacturing fixture ... comprising ... a fixture body including a fixture cavity ... having a cavity axis which is substantially parallel with the first region axis when the magnet is in the fixture cavity, ... and an orientating device adapted to create a magnetic field having flux lines which extend through a portion of the fixture cavity, wherein a portion of the flux lines in the fixture cavity are angled relative to the cavity axis, a portion of the flux lines near the cavity transition extend substantially transversely to the cavity axis, a portion of the flux lines in the fixture cavity are substantially parallel to the cavity axis, and a portion of the flux lines in the cavity fixture positioned near a cavity perimeter are angled relative to the cavity axis." New claim is considered to be patentable in view of the cited references. New claim 60 depends from new claim 59 and is likewise considered patentable.

Version with markings to show changes mad :

Claims 1, 5, 8, 11, 19, 21 and 25 were amended as set forth below:

1. (First Amended) A manufacturing fixture [which is useful] for manufacturing a magnet from a magnet powder, the magnet including a north pole, a south pole and a first region axis which extends between the north pole and the south pole, the manufacturing fixture comprising:

a fixture body including a fixture cavity for receiving the magnet powder, the fixture cavity having a cavity axis which is substantially parallel with the first region axis when the magnet is in the fixture cavity, the fixture cavity including a first region; and

an orientating device adapted to create a magnetic field having flux lines which extend through a portion of the fixture cavity, wherein a portion of the flux lines in the first region of the fixture cavity are substantially parallel to the cavity axis, and a portion of the flux lines outside of the first region of [in] the fixture cavity are angled relative to the cavity axis.

5. (First Amended) The fixture of claim [4] 1 wherein a portion of the flux lines in the cavity fixture positioned near a cavity perimeter are angled relative to the cavity axis.

8. (First Amended) The fixture of claim 1 wherein the fixture cavity includes an upper side and a lower [bottom] side and the orientating device includes a coil positioned near one of the sides of the fixture cavity.

11. (First Amended) A fixture [which is useful] for manufacturing a permanent magnet, the permanent magnet having a magnet body which is made of a magnet powder, the magnet body having a first segment which includes a first region and a second region, the first region having a first region axis which extends between a north pole and a south pole of the first region, the fixture comprising:

a fixture body including a fixture cavity which is adapted to receive the magnet powder; and

an orientating device adapted for aligning a portion of the magnet powder in the fixture cavity to form a powder pattern in the magnet body having second region powder lines in at least a portion of the second region which are angled relative to the first region axis.

19. (First Amended) The fixture of claim 11 wherein the fixture cavity includes an upper side and a lower [bottom] side and the orientating device includes a coil positioned near one of the sides of the fixture cavity.

21. (First Amended) A method for manufacturing a magnet from a magnet powder, the magnet including a north pole, a south pole and a first region axis which extends between the north pole and the south pole, the method comprising the step of:

providing a fixture cavity, the fixture cavity having a cavity axis which is substantially parallel with the first region axis when the magnet is in the fixture cavity;

positioning the magnet powder in the fixture cavity;[,] and

creating flux lines which extend through a portion of the fixture cavity, wherein a portion of the flux lines in the fixture cavity are angled relative to the cavity axis and a portion of the flux lines in the fixture cavity are substantially parallel to the cavity axis.

25. (First Amended) The method of claim [24] 21 wherein the step of creating flux lines includes creating flux lines in the cavity fixture near a cavity perimeter which are angled relative to the cavity axis.

REMAINING REFERENCES

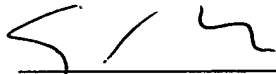
The references cited by the Examiner, but not relied on for the rejection of claims, have been noted. The remaining references are no more pertinent than the applied references, therefore, a detailed discussion of these remaining references is deemed unnecessary for a full and complete response to the Office Action.

CONCLUSION

In conclusion, Applicants respectfully assert that claims 1-3, 5, 8-23, 25 and 27-60 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-456-1951 for any reason that would advance the instant application to issue.

Dated this 16th day of July, 2001.

Respectfully submitted,



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